

Attorney. Docket No. 035451-0185 (3731.Palm)

REMARKS

Applicants respectfully request reconsideration of the present application in view of the reasons that follow.

Claims 1-15 and 17-29 are pending in the application.

A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, is presented, with an appropriate defined status identifier.

Claim Rejections – 35 U.S.C. § 103(a)

In Section 4 of the Office Action, claims 1-15 and 17-29 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Moriconi et al. (U.S. Patent No. 6,590,547).

Claims 1, 15, 22, and 26

With regard to claims 1, 15, 22, and 26, Applicants respectfully submit that the Examiner has failed to establish a prima facie case of obviousness. More specifically, for at least the reasons stated below, no proper combination of Moriconi et al. with knowledge generally available to one of ordinary skill in the art teaches or suggest the subject matter of claims 1, 15, 22, and 26.

To establish a prima facie case of obviousness based on a combination of a prior art reference under 35 U.S.C. § 103(a) and knowledge of one of ordinary skill in the art, the Examiner must first show that there is a suggestion or motivation to combine the teachings of those references. This may come in the form of some objective teaching in the prior art or, alternatively, knowledge generally available to one of ordinary skill in the art at the time of the invention that would lead that individual to combine the relevant teachings of the references. When the motivation to combine the teachings of the references is not immediately apparent, it is the duty of the Examiner to explain why the combination of the teachings is proper. Ex parte

Attorney, Docket No. 035451-0185 (3731.Palm)

Skinner, 2 USPQ.2d 1788 (Bd. Pat. App. & Inter. 1986). In this case, the Examiner has not shown that there would have been any motivation or suggestion to one of skill in the art to combine general knowledge with the teachings of Moriconi et al.

The final Office Action acknowledges that "Moriconi does not specifically teach the user of handheld computing device." However, the final Office Action further states that "Moriconi indicates that the notebook computer (11) is applicable for portable computers (col. 1, lines 17-19), and alteration and different arrangement can be made with respect to the notebook computer (11) (col. 6, lines 35-47). The final Office Action concludes that "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the notebook computer (11) by altering its dimensional parameters to fit the desired size." The final Office Action further asserts in response to Applicants arguments filed on July 20, 2005 that "[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the notebook computer (11), which is applicable for portable computers (as taught by Moriconi) by altering its dimensional parameters to fit the desired size; the being that it is well known in the art that portable computers include computers small enough to be carried by hand." Applicants, respectfully disagree.

In one of the two passages relied on in the Office Action to support the above assertions, Moriconi et al. discloses only generally that "[t]his invention is in the field of architecture of portable computers, and pertains in particular to apparatus and methods of interfacing removable physical displays to portable computers." See Moriconi et al., col. 1, lines 17-19). In the other passage relied on in the Office Action, Moriconi et al. provides only the general boilerplate language found in most patent documents that "many changes may be made in the embodiments of the invention as described above without departing from the spirit and scope of the invention." Applicants respectfully submit that a single broad reference to portable computers in Moriconi et al. coupled with general boilerplate language and an assertion that portable computers include computers small enough to be carried by hand is insufficient to establish any motivation or

Attorney, Docket No. 035451-0185 (3731.Palm)

suggestion to one of skill in the art to combine general knowledge with the teachings of Moriconi et al. to somehow arrive at the subject matter of claims 1, 15, 22, and 26.

Moreover, Applicants note that the specific teachings of Moriconi et al. relate to portable computers "such as notebook and laptop computers." See Moriconi et al., col. 1, lines 23-24. Applicants have submitted ample evidence and arguments in their previous replies dated March 15, 2004 and July 20, 2005 that a "handheld computer" is "a computer that can conveniently be stored in a pocket (of sufficient size) and used while you are holding it" and should not be construed as a laptop or notebook computer. A laptop or notebook computer as disclosed in Moriconi et al., is not one which can conventionally be carried in your pocket.

Further still, it should be appreciated that the Applicant may be his or her own lexicographer as long as the meaning assigned to the term is not repugnant to the terms' well known usage. In re Hill, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). Accordingly, Applicants refer the Examiner to the specification which states at paragraph [0003] "the size of the handheld computing device is generally compact and correspondingly, the visual display is smaller than the size of a standard computer monitor. The small size of the screen allows handheld computing devices to be portable, but less than ideal for viewing complex images of documents. The small size of the screen has necessitated that handheld computing devices focus on displaying abbreviated or simplistic content." In contrast, the laptop or notebook computer of Moriconi et al. has a display which is relatively large and could easily be used for viewing complex images of documents, for example. Further, Applicants refer the Examiner to paragraph [0022] which states that a handheld computer can be "a handheld personal digital assistant (PDA), a wireless mobile phone, a pager, or any such device." As is well known, all of these devices are approximately the size which could be conveniently carried in your pocket. Thus, it is clear that the Applicants have defined the term "handheld computer" within specified constraints which would not include the laptop and notebook computer of Moriconi et al. Accordingly, Applicants respectfully submit that, while Moriconi et al. makes a general reference to "portable computers" and "many changes that may be made," its specific teachings relate only to laptops and notebook

Attorney, Docket No. 035451-0185 (3731.Palm)

computers, and one of ordinary skill in the art would recognize the differences between these devices and handheld computers, and would further recognize that the specific teachings of Moriconi et al. do not necessarily suggest applicability to all portable devices regardless of size.

The Office Action, however, states that “[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the notebook computer (11), which is applicable for portable computers (as taught by Moriconi) by altering its dimensional parameters to fit the desired size; the being that it is well known in the art that portable computers include computers small enough to be carried by hand.” The Office Action thus implies that if it is “well known in the art that portable computers include computers small enough to be carried by hand,” it is thus equally well known to simply alter physical size parameters of any portable computing device to obtain a desired configuration and scale, that that thus there is no difference between a laptop computer and a handheld computer. As noted in Manual of Patent Examining Procedure § 2143.03, there must be some form of evidence in the record to support an assertion of common knowledge. See also In re Zurko, 258 F.3d 1379, 1386, 59 U.S.P.Q.2d 1693, 1697 (Fed. Cir. 2001); In re Lee, 277 F.3d 1338, 1344-45, 61 U.S.P.Q.2d 1430, 1434-35 (Fed. Cir. 2002). However, the Examiner has provided no support for the implication that, despite the above-noted differences between laptops and handheld computers, one of ordinary skill in the art would simply apply the teachings of Moriconi et al. regarding laptops and notebook computers to arrive at the handheld computer of claims 1, 15, 22, and 26 by making the laptop smaller based on (1) a general reference in Moriconi et al. to portable computing devices and (2) asserted knowledge that that both laptops and handheld computers are portable.

In further support, Applicants refer the Examiner to their specification which describes how the advent of the handheld computer has brought about a need for the subject matter of claims 1, 15, 22, and 26. For example, Applicants refer the Examiner to pages 1 -3 of the application, paragraphs [0003] to [0008]. In these paragraphs, the Applicants provide meaningful reasons for needing the claimed invention, including, but not limited to the fact that

Attorney. Docket No. 035451-0185 (3731.Palm)

handheld computing devices were at the time of the invention, in transition and therefore it would have been beneficial to provide an interchangeable display unit. Further, and possibly more importantly, because the needs of different users of the handheld computing unit may be vastly different due to its extremely small size and extreme portability, there may be a need to interchange displays for a single user or for different users. Therefore, there is a significant reason for Applicants to provide interchangeable display modules for a handheld computing device. As such, Applicants have claimed a handheld computing device in claims 1, 15, 22, and 26.

Because the Office Action does not properly establish motivation to combine the teachings of Moriconi et al. with knowledge generally available to one of ordinary skill in the art, the Office Action fails to establish a proper case of obviousness. The alleged motivation cited in the Office Action is thus similar to reasoning which was held to be insufficient to support a motivation to combine teachings of cited references by the U.S. Court of Appeals for the Federal Circuit. In re Lee, 277 F.3d 1338, 61 USPQ.2d 1430 (Fed. Cir. 2002). In that case, the Board stated that the "conclusion of obviousness may be made from common knowledge and common sense of a person or ordinary skill in the art without any specific hint or suggestion in a particular reference." The Federal Circuit rejected this logic, stating that "neither the examiner nor the Board adequately supported the selection and combination of the . . . references to render obvious that which Lee described." Without a proper motivation to combine the teachings of Moriconi et al. with knowledge of one of ordinary skill in the art, it is apparent that hindsight reasoning has been used that relies on the Applicant's own disclosure as a roadmap.

Accordingly, Applicants respectfully request that the rejection of claims 1, 15, 22, and 26 under 35 U.S.C. § 103(a) be withdrawn. Additionally, claims 2-14 (which depend from claim 1), claims 17-21 (which depend from claim 15), claims 23-25 (which depend from claim 22), and claims 27-29 (which depend from claim 26) are patentable for at least the same reasons as the independent claims from which they depend, and Applicants request that the rejection of these claims under 35 U.S.C. § 103(a) be withdrawn as well. See 35 U.S.C. § 112 ¶ 4.

Attorney. Docket No. 035451-0185 (3731.Palm)

Claims 4, 5, 23, and 24

Even if the teachings of Moriconi et al. could be properly combined with the knowledge generally available to one of ordinary skill in the art and, claims 4, 5, 23, and 24 still would not have been obvious to one of ordinary skill in the art at the time of the invention for the following additional reasons.

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art (see M.P.E.P. § 2143.03). The Examiner's rejection of claims 4, 5, 23, and 24 under 35 U.S.C. § 103(a) over Moriconi et al. is improper and should be withdrawn because at least one limitation of each of these claims is not taught or suggested by the cited combination of Moriconi et al. in view of knowledge of one of ordinary skill in the art, and therefore these claims would not have been obvious to one of ordinary skill in the art at the time of the invention.

With regard to claims 4, 5, 23, and 24, Moriconi et al. does not disclose, teach, or suggest a flexible, expandable, or foldable display. The need for a flexible, expandable, or foldable display is a unique need for a handheld computing device. In fact, the teachings of Moriconi et al. of a laptop or notebook computer, provide no advantage for a expandable, flexible, or foldable display, because the laptop or notebook computer of Moriconi et al. is already a large enough size for a typical user and therefore an expandable or foldable display is not required. Moriconi et al., as the Examiner indicated, teaches the use of a variety of displays, but Moriconi et al. never contemplated a flexible and expandable display as recited in Applicants' claims because a larger display was not needed by users of the laptop or notebook computers of Moriconi et al. Because Moriconi et al. does not disclose, teach, or suggest a flexible, expandable, or foldable display, Applicants respectfully submit that the rejection of claims 4, 5, 23, and 24 under 35 U.S.C. § 103(a) should be withdrawn.

Attorney. Docket No. 035451-0185 (3731.Palm)

Claims 2, 20, and 21

Even if the teachings of Moriconi et al. could be properly combined with the knowledge generally available to one of ordinary skill in the art and, claims 2, 20, and 21 still would not have been obvious to one of ordinary skill in the art at the time of the invention for at least the following additional reasons.

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art (see M.P.E.P. § 2143.03). The rejection of claims 2, 20, and 21 under 35 U.S.C. § 103(a) based on Moriconi et al. in view of knowledge of one of ordinary skill in the art is improper and should be withdrawn because at least one limitation of each of claims 2, 20, and 21 is not taught or suggested by the cited combination of Moriconi et al. in view of knowledge of one of ordinary skill in the art.

In the final Office Action, the Examiner stated that "Moriconi teaches the first communication interface includes a wireless communication interface (col. 4, lines 57-59, Fig. 2 (39), and Fig 4 (40, 39))." Applicants respectfully submit that Moriconi et al. does not teach the use of wireless connections for the display device. Moriconi et al. discloses only that "a display board 41 is incorporated into the computer with connection to the system parallel bus 52, and having output to 40-pin connector 39 along path 40." See Moriconi et al., col. 4, lines 59-61. What is taught in Moriconi et al. is that the display is coupled to and supported by the housing of the laptop or notebook computer and therefore there is no need for a wireless connection. Moriconi et al. never contemplated a wireless connection between the display unit and the laptop or notebook computer main unit because Moriconi et al. did not foresee a need for a wireless connection. In contrast, Applicants contemplate that the display device may be used not only while attached to the handheld computing device, but also while being separated from the handheld computing device. See, e.g., pages 6-7, paragraph [0026]. Applicants contemplate that there may exist a wireless connection between the handheld computing device providing advantages which were not contemplated by Moriconi et al.

Attorney, Docket No. 035451-0185 (3731.Palm)

Although Moriconi et al. does not teach the use of wireless connections for the display device (and indeed does not contemplate a need for such connection) the Examiner has simply asserted that "[i]t would have been obvious that the connector (39) for communication can be replaced with any other appropriate type." As noted in Manual of Patent Examining Procedure § 2143.03, there must be some form of evidence in the record to support an assertion of common knowledge. See also In re Zurko, 258 F.3d 1379, 1386, 59 U.S.P.Q.2d 1693, 1697 (Fed. Cir. 2001); In re Lee, 277 F.3d 1338, 1344-45, 61 U.S.P.Q.2d 1430, 1434-35 (Fed. Cir. 2002). Here, the Examiner has provided no support for the assertion that the connector of Moriconi et al. could simply be replaced with a wireless communication interface. Accordingly, Applicants respectfully request that the rejection of claims 2, 20, and 21 be withdrawn because at least one element of claims 2, 20, and 21 is not taught or suggested by any proper combination of knowledge of one of ordinary skill in the art and Moriconi et al.

Conclusion

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 06-1447. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 06-1447.

Attorney. Docket No. 035451-0185 (3731.Palm)

If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 06-1447.

Respectfully submitted,

Date 12/5/2005

By Chad E. Bement

FOLEY & LARDNER LLP
Customer Number: 26371
Telephone: (414) 297-5554
Facsimile: (414) 297-4900

Chad E. Bement
Attorney for Applicants
Registration No. 54,991